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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,490	01/11/2007	Yasunobu Suzuki	294276US0X PCT	1684
22850 7590 12/19/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER TREIDL, JESSICA I	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			12/19/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/593,490	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> JESSICA TREIDL	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/20/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 7, the phrase “high refractive index” is indefinite and unclear, as it is unclear what Applicant considers to be a high refractive index.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi et al (WO 01/81466).

Regarding claims 1-2, Yamaguchi et al teach a curable resin composition (Abstract) comprising reactive particles prepared by bonding oxide particles of an element selected from the group consisting of silicon, aluminum, zirconium, titanium,

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zinc, germanium, indium, tin, antimony, and cerium and an organic compound having a polymerizable unsaturated group bonded to the metal oxide particle (Abstract), a polysiloxane compound containing a urethane group and 2-3 methacryloyl groups (19:5-18, 18:1-5, 21:20-22:15 wherein  $n = 2-3$ ), a further compound having two or more polymerizable unsaturated groups {instant claim 2} (15:17-25), and a photoinitiator (28:7-29:10).

Regarding claims 3 and 4, Yamaguchi et al teach the metal oxide particle being antimony-doped tin oxide (6:25), and the compound bonded thereto having the structure of instant formula (1) (8:25-9:25).

Regarding claims 5, 6 and 9, Yamaguchi et al teach a laminate comprising a film of the cured composition on a substrate (32:13-20).

Regarding claim 7, Yamaguchi et al do not positively state the refractive index of the cured film. However, the reference teaches all of the claimed reagents. Therefore, the claimed effects and physical properties, i.e. having a high refractive index, would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

Regarding claims 8 and 10, Yamaguchi et al teach laminating a substrate with a low-refractive layer, having a refractive index of 1.38, and laminating on top of the lower refractive index layer the cured composition (51:29-52:14).

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Regarding claim 11, Yamaguchi et al teach the laminate having an adhesion, wherein the adhesion is measured by a cross-cut peeling test according to JIS K5400, of 100 % (see Table 2, 39:24-27).

Regarding claim 12, Yamaguchi et al teach the laminate having a surface resistivity of  $3 \times 10^9 \Omega$  (51:16-28).

Regarding claim 14, Yamaguchi et al do not teach the haze value of the cured composition. However Yamaguchi et al teach the composition forming coatings with high transparency (2:8-9), and evaluate the transparency in terms of good or bad (40:15-20), wherein the reference found the cured laminate to have good if not superior transparency (Table 2, 51:27, 52:14). The Office realizes that Yamaguchi et al do not teach the haze value of the cured composition. However, the reference teaches all of the claimed reagents and teaches the cured composition to have good and superior transparency. Therefore, the claimed effects and physical properties, i.e. having a haze value of 0.22 or higher, would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

Regarding claim 15, Yamaguchi et al teach the laminate being an antistatic antireflection laminated body (51:16).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 9, and 12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 5, 7, 14, 15, and 17 of U.S. Patent No. 7,122,253 {‘253}. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Regarding claims 1 and 2, ‘253 teaches all of the instant limitations, wherein it would be obvious to choose the polysiloxane having a urethane bond and at least one polymerizable unsaturated group to contain two or more polymerizable unsaturated groups in an effort to increase reactivity and curability. Furthermore ‘253 does not teach the curable composition containing a photoinitiator in the reference claims. However ‘253 does teach the composition comprising a photoinitiator in the specification (20:26-

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21:10). Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. In re Vogel, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970). Therefore, it would have been obvious to one of ordinary skill in the art to add a photoinitiator. In absence of the specification, it also would have been obvious to one of ordinary skill in the art at the time of invention to add an initiator to the composition in an effort to increase curing speed and depth. The choice of a photoinitiator would have required nothing more than choosing from a short list of types of initiators including heat, light, and moisture.

Regarding claim 4, '253 teaches the metal oxide particle being selected from a short list provided in reference claim 4. Selecting antimony-doped tin oxide would require nothing more than selecting a suitable metal oxide from a short list.

Regarding claims 3, 5, 6, 9, and 12, '253 teaches the instant limitations in reference claims 5, 14, and 17.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA TREIDL whose telephone number is (571)270-3993. The examiner can normally be reached on Monday- Thursday, 7:30AM- 5PM EST, Alt. Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.T./  
/12.11.08/

/Sanza L McClendon/

Primary Examiner,

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